

App. No. 10/731,897
Amendment Dated January 18, 2007
Reply to Office Action of July 19, 2006

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REMARKS

Applicants respectfully request entry of the foregoing amendments and consideration of the following remarks.

Claims 1-21 were pending at the time of the Office Action, of which claims 1, 13, and 20 are independent claims. Claims 1-19 were rejected under 35 U.S.C. § 101 as not being directed to statutory subject matter. Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bott, "Using Microsoft Office 2000," (Que Corporation, 1999) (hereinafter "Bott") in view of U.S. Publication No. U.S. 2005/0091231 A1 filed October 24, 2003 (hereinafter "Pal"). Applicants respectfully traverse these rejections.

Independent claims 1 and 13 are amended to resolve the rejections to claims 1-19 under 35 U.S.C. § 101. Independent claim 19 also has been amended; however, the amendment to claim 19 corrects a grammatical mistake, and the amendment was not made in response to the Office Action. The following remarks address why the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103(a) should be withdrawn against claims 1-21.

Claim Rejections under 35 U.S.C. § 101

In the interest of reducing the number of issues for the Examiner to consider in this response, the following discussion regarding the rejections under 35 U.S.C. § 101 focuses on independent claims 1 and 13. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the

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rejections of each dependent claim should not be considered as an admission that applicants concur with the Office Action's conclusion that these dependent claims are not patentable under 35 U.S.C. § 101.

The Office Action asserts that claims 1-19 are not directed to statutory subject matter and thus are not patentable under 35 U.S.C. § 101. Specifically, the Office Action asserts that "the language of the claims raise a question as to whether the claims are directed to merely an abstract idea that would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101." (Office Action, page 3). With regard to each of claim sets 1-12 and 13-19, the Office Action more specifically states the purported shortcomings of the claims:

Stated differently, the method does nothing with the processed data that produces a concrete, useful and tangible result, such as displaying the computer-generated document.

(Office Action, Page 4; emphasis added.)

Applicants have amended independent claims 1 and 13 to resolve this rejection. Claim 1 as amended is reproduced below for the convenience of the Examiner:

1. (Currently Amended) A computer-implemented method of replicating a table row in a computer-generated document, comprising:
selecting a source row for replication;
parsing the source row to determine a number and a size of row cells contained in the source row;
parsing the source row to determine Extensible Markup Language (XML) markup applied to the source row; and
automatically replicating the source row to create a second row that is a replica of the source row; and

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causing the computer-generated document to be displayed with the second row having the number and the size of the row cells contained in the source row.

Claim 13 as amended also is reproduced below for the convenience of the Examiner:

13. (Currently Amended) A computer-implemented method of replicating a table row in a computer-generated document, comprising:
selecting a source row in the table for replication;
parsing the source row to determine a number and a size of row cells contained in the source row;
parsing the source row to determine Extensible Markup Language (XML) markup applied to the source row; and
automatically replicating the source row to create a second row that includes the same number and size of cells as the source row and that includes the same XML markup as the source row; and
causing the computer-generated document to be displayed with the second row having the number and the size of the row cells contained in the source row.

The Office Action, as an example, noted that "displaying the computer-generated document" is a limitation that would overcome the assertion that the claims "do nothing with the processed data that produces a concrete, useful and tangible result." Accordingly, Applicants have amended independent claims 1 and 13 to recite "causing the computer-generated document to be displayed" to resolve this rejection. Applicants respectfully assert that the rejection under 35 U.S.C. § 101 should be withdrawn from amended claims 1 and 13.

Because claims 2-12 depend from and apply additional limitations to claim 1, and claims 14-19 depend from and apply additional limitations to claim 13, claims 2-12 and 14-19 also overcome the rejection and are patentable under 35 U.S.C. § 101 and are patentable for at least the same reasons as the claims from which they depend. Accordingly, applicants respectfully assert that the rejection under 35 U.S.C. § 101 should be withdrawn from claims 2-12 and 14-19.

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In sum, applicants respectfully submit that the rejection under 35 U.S.C. § 101 be withdrawn against claims 1-19.

Claim Rejections under 35 U.S.C. § 103

The Office Action asserts that claims 1-21 are unpatentable under 35 U.S.C. § 103(a) over Bott in view of Pal. Respectfully, however, the cited reference to Pal does not qualify as prior art. Thus, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

The Pal reference does not qualify as prior art under 35 U.S.C. § 103(c)(1) because both Pal and the current application were subject to an obligation of assignment to or owned by the same entity, Microsoft Corporation, at the time the claimed invention was made. The statute makes clear that, to qualify as prior art, the subject matter of the reference must have been developed by another person:

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(35 U.S.C. § 103(c)(1).) The Pal reference only *potentially* qualifies as prior art under 35 U.S.C. § 102(e) as subject matter that was described in “an application for patent, published under section 122(b), by another filed in the United States before the invention.” (35 U.S.C. § 102(e); emphasis added.) However, Pal does not qualify as prior art because the subject matter was owned by and/or subject to an obligation of assignment to the same entity, Microsoft Corporation, and thus is not considered an application “by another.”

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The undersigned attorney, by his signature, attests that the subject matter described in the application of Pal and the claimed invention as recited in the current application both are owned by Microsoft Corporation, Redmond, Washington.

Accordingly, Pal fails to qualify as prior art. Applicants thus submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn against claims 1-21.

Applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited.

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CONCLUSION

In view of the foregoing amendments and remarks, the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103(a) both should be withdrawn against the claims. Applicants submit that claims 1-21 are in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,

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